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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MAURIZIO TAMBURRO, NICOLA D'ALESIO,
ANTONELLA PESCE, ACHILLE DI CINTIO,
GIOVANNI CARLUCCI, and ANDELLA ALESSANDRA

Appeal 2009-015252
Application 10/785,464
Technology Center 1700

Before, MICHAEL P. COLAIANNI, BRADLEY R. GARRIS, and
BEVERLY A. FRANKLIN, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

Appellants appeal under 35 U.S.C. § 134 from the Examiner's
rejection of claims 1-12. We have jurisdiction under 35 U.S.C. § 6(b).

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Claim 1 is representative of the subject matter on appeal and is set forth below:

1. A disposable absorbent article comprising:

a liquid pervious topsheet; a liquid impervious backsheet; and an absorbent member positioned between said topsheet and said backsheet, said absorbent member having a thickness dimension, a first surface being oriented towards said topsheet and an opposed second surface being oriented towards said backsheet, said second surface being separated from said first surface by said thickness dimension, said absorbent member comprises at least one continuous and homogeneous region of a sprayed on layer of particles of chitosan material, wherein said chitosan material spans across void spaces located on or within the absorbent member and at least partially covers constituent materials of the absorbent material, wherein said particles of chitosan have a particle size distribution with a mean diameter $D(v,0.9)$ of not more than about 300 μm , wherein at least 1 gram of said chitosan material is soluble in 100 grams of water at 25°C and one atmosphere.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Kellenberger '823	4,699,823	Oct. 13, 1987
Kellenberger '933	5,496,933	Mar. 5, 1996
Sackmann	5,635,569	Jun. 3, 1997
Pesce	US 6,833,487 B2	Dec. 21, 2004
Carlucci '287	US 6,867,287 B2	Mar. 15, 2005
Gagliardini	US 6,887,564 B2	May 3, 2005
Carlucci '364	US 2005/0154364 A1	Jul. 14, 2005

THE REJECTION(S)

1. Claims 1-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelkenberg '933 in view of Kellenberger '823 and Sackmann.
2. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,833,487 in view of Kellenberger '823 and Sackmann.
3. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-24 of U.S. Patent No. 6,867,287 in view of Kellenberger '823 and Sackmann.
4. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-21 of U.S. Patent No. 6,887,564 in view of Kellenberger '823 and Sackmann.
5. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-20 of copending Application 11/021,634 in view of Kellenberger '823 and Sackmann.

On page 4 of the Answer², the Examiner indicated that the following rejections were not addressed by Appellants' in their Brief:

6. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

² We use the Supplemental Answer mailed on June 10, 2009.

claims 1-10 of copending Application No. 10/785,277 in view of Kellenberger '823.³

7. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,887,564 in view of Kellenberger '823 and Sackmann.⁴

8. Claims 1-6, 8, 9, 11, and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 11/021,634 in view of Kellenberger '823.⁵

ISSUE(S)

Did the Examiner err in determining that the applied art suggests the aspects of the claimed invention directed to “a continuous and homogeneous region of chitosan” wherein “at least 1 gram of the chitosan material is soluble in 100 grams of water at 25°C”?

We answer this question in the negative.

³ Application No. 10/785,277 was abandoned on July 27, 2007. Hence, this rejection is rendered moot.

⁴ Because Appellants did not argue this rejection, we treat such action as a waiver and affirm this rejection.

⁵ Because Appellants did not argue this rejection, we treat such action as a waiver and affirm this rejection. We note that Application No. 11/021,634 was allowed and is now U.S. Patent No. 7,537,832.

FINDINGS OF FACT, PRINCIPLES OF LAW, and ANALYSIS

As an initial matter, we confine our discussion to appealed claim 1, which contains claim limitations representative of the arguments made by Appellants, pursuant to 37 C.F.R. § 41.37(c)(1)(vii).

We refer to the Examiner's fact findings and response as presented on pages 5-29 of the Answer. We add the following for emphasis only.

Beginning on page 3 of the Brief, Appellants argue that the applied references do not suggest a continuous and homogeneous region of chitosan. Appellants argue that the structure of the continuous and homogeneous region of chitosan is analogous to the structure of a layer of salt created in the bottom of a glass by allowing a glass of salt water to dry over many days. Appellants explain that the layer of salt formed on the bottom of the glass is continuous and homogeneous, and that many of the particles of salt are linked to adjacent particles of salt. Appellants explain that the salt at the bottom of the glass has a structure that is distinct from that of grains of salt, even very small grains of salt, poured into a dry glass to form a layer of salt at the bottom a glass, and that when grains of salt poured into a dry glass, the grains are finely dispersed. Appellants submit that their Figures 2 and 3 show that the particles of chitosan are not finely dispersed; rather the particles of chitosan form a continuous and homogeneous region of chitosan material.

On page 4 of the Brief, Appellants argue that the powders of Kellenberger '823 and Sackman are like grains of dry salt poured into a dry glass, and therefore not the same as claimed.

We are not convinced by the above-mentioned arguments. We agree with the Examiner's response made on pages 19-20 of the Answer, and we incorporate the Examiner's analysis herein. We add that the concept of Appellants' analogy that the claimed region is likened to a layer of salt formed on the bottom of a glass after a glass of salt water is allowed to dry over many days is not reflected in the claims. That is, Appellants argue limitations not recited in the claims, and therefore such arguments are not convincing. It is the claims that define the invention and, therefore, the absence in the prior art of subject matter not included in the claims cannot be a basis for patentability. *See Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571 (Fed. Cir. 1988); *see In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) ("Many of appellant's arguments fail from the outset because . . . they are not based on limitations appearing in the claims.").

Regarding the solubility limitation of the chitosan material, Appellants assert that the Examiner has not met his burden of showing why this claimed feature is inherent in the teachings of Kelkenberger '933. Br. 4-5. We are not convinced by Appellants' assertion and agree with the Examiner's response made on pages 20-21 of the Answer. Appellants do not address the Examiner's explanation of why Kelkenberger '933 inherently meets this aspect of the claims other than to broadly assert that the Examiner does not meet his burden. On the other hand, the Examiner provides a reasonable foundation for his position. We note that when the Examiner puts forth a finding of inherency, the Examiner must provide enough evidence or scientific reasoning to establish that the Examiner's belief that the property is inherent is a reasonable belief. *Ex parte Levy*, 17 USPQ2d 1461, 1464-65 (BPAI 1990); *Ex parte Skinner*, 2 USPQ2d 1788,

1789 (BPAI 1986). Appellants have not explained why they believe the Examiner has not done so. Also, where the Examiner has reason to believe that a claimed property may, in fact, be an inherent characteristic of the prior art product, an Examiner possesses the authority to require applicant to prove that the subject matter shown to be in the prior art does not in fact possess the property. *In re Best*, 562 F.2d 1252, 1254-55 (CCPA 1977). Appellants have not satisfied this burden.

In view of the above, we affirm with the Examiner's rejection.

2. The Rejection of claims 1-12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,833,487 in view of Kellenberger '823 and Sackmann.

For this rejection, with respect to the recited solubility of the chitosan material, the Examiner's position is that such a property would be inherent to the chitosan salts claimed in the '487 Patent since the patent claims chitosan salt known to be soluble in water (claims 5 and 15) and since claim 8 of the present invention discloses that chitosan salts meet the limitation. Ans. 12, 22-23. Appellants do not specifically address this position by the Examiner (Appellants merely assert that the claimed subject matter is not inherent in the applied art. Br. 5). On the other hand, the Examiner presents a reasonable foundation to support his position. We therefore agree with the Examiner's position. *Ex parte Levy* at 1464-65; *Ex parte Skinner* at 1789; *In re Best* at 1254-55.

With regard to the continuous and homogeneous region of chitosan recitation, our determination is the same as explained, *supra*.

3. The rejection of claims 1-12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-24 of U.S. Patent No. 6,867,287 in view of Kellenberger '823 and Sackmann.

For this rejection, with respect to the recited solubility of the chitosan material, the Examiner's position is that such a property would be inherent to the chitosan salts claimed in the '287 Patent since the patent claims chitosan salt known to be soluble in water (claim 4) and since claim 8 of the present invention discloses that chitosan salts meet the limitation. Ans. 13, 24-25. Appellants do not specifically address this position by the Examiner (Appellants merely assert that the claimed subject matter is not inherent in the applied art. Br. 6). On the other hand, the Examiner presents a reasonable foundation to support his position. We therefore agree with the Examiner's position. *Ex parte Levy* at 1464-65; *Ex parte Skinner* at 1789; *In re Best* at 1254-55.

With regard to the continuous and homogeneous region of chitosan recitation, our determination is the same as explained, *supra*.

4. Claims 1-12 were rejected under the judicially created doctrine of obviousness- type double patenting as being unpatentable over Claims 1-21 of U.S. Patent No. 6,887,564 in view of Kellenberger '823 and Sackmann.

For this rejection, with respect to the recited solubility of the chitosan material, the Examiner's position is that such a property would be inherent to the chitosan salts claimed in the '564 Patent since the patent claims chitosan salt known to be soluble in water (claim 8) and since claim 8 of the present invention discloses that chitosan salts meet the limitation. Ans. 15, 26-27. Appellants do not specifically address this position by the Examiner (Appellants merely assert that the claimed subject matter is not inherent in

the applied art. Br. 7). On the other hand, the Examiner presents a reasonable foundation to support his position. We therefore agree with the Examiner's position. *Ex parte Levy* at 1464-65; *Ex parte Skinner* at 1789; *In re Best* at 1254-55.

With regard to the continuous and homogeneous region of chitosan recitation, our determination is the same as explained, *supra*.

5. Claims 1-12 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-20 of copending Application 11/021,634 in view of Kellenberger '823 and Sackmann.

For this rejection, with respect to the recited solubility of the chitosan material, the Examiner's position is that such a property would be inherent to the chitosan salts claimed in the '634 Application since the patent claims chitosan salt known to be soluble in water (claim 4) and since claim 8 of the present invention discloses that chitosan salts meet the limitation.

Ans. 17, 28-29. Appellants do not specifically address this position by the Examiner (Appellants merely assert that the claimed subject matter is not inherent in the applied art. Br. 6). On the other hand, the Examiner presents a reasonable foundation to support his position. We therefore agree with the Examiner's position. *Ex parte Levy* at 1464-65; *Ex parte Skinner* at 1789; *In re Best* at 1254-55.

With regard to the continuous and homogeneous region of chitosan recitation, our determination is the same as explained, *supra*.

CONCLUSIONS OF LAW

The Examiner did not err in determining that the applied art suggests the aspects of the claimed invention directed to “a continuous and homogeneous region of chitosan” wherein “at least 1 gram of the chitosan material is soluble in 100 grams of water at 25C”.

DECISION

Rejections 1-5 are affirmed

Rejections 6, 7, and 8 are decided as set forth in footnotes 3-5, *supra*.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED

PL initial
sld

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